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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,972	12/30/2003	Patrick Zuili	BSM-10004/29	9010
26797 7590 02/09/2007 SILICON VALLEY PATENT AGENCY 7394 WILDFLOWER WAY CUPERTINO, CA 95014			EXAMINER LEE, SEUNG H	
			ART UNIT 2876	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			02/09/2007	
			DELIVERY MODE	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/747,972	Applicant(s) ZUILI, PATRICK	
	Examiner Seung H. Lee	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the response filed on 15 November 2006, which has been entered in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5-6, 8, 9, 13, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (US 6,612,488).

Re claims 1, 5-6: Suzuki teaches a method of conducting transaction comprising connecting a card transaction terminal (300) serving as a separate unit to a cellular phone (100) serving as a device wherein the cellular phone having a keypad and display, the transaction terminal operating securely and independently from the cellular phone, initiating a transaction using the cellular phone col. 10, lines 8-11) and communicating the transaction request to an transaction authorization computer (400) serving as a third party, receiving a transaction complete signal at the card transaction terminal via the cellular phone, wherein the card transaction terminal is caused to

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request the personal data from the cellular phone to conduct the transaction (see figs. 1-8; col. 9, line 5- col. 11, line 30),

Re claims 8, 9, and 13: A DTMF (Dual Tone Multiple Frequency) is tone signal is used to transmit the PIN input at the cellular phone (col. 10, lines 37-44),

Re claims 16 and 17: The PIN can be encrypted to increase the security using well-known public-key cryptography (not particularly disclosed)(col. 10, lines 45-48),

Re claims 18: The transaction data can be stored (col. 10, lines 57-62).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Norton (US 6,572,015, of record).

The teachings of Suzuki have been discussed above.

Although, Suzuki teaches a card transaction terminal comprises a card reader, they fails to teach or fairly suggest that the card reader is capable of reading an optical card.

However, Norton teaches a smart card reader (42) wherein the card reader can read various type of smart cards including a contactless smart card (10), an optical smart card (70), and etc. (see fig. 6b; col. 11, line 5- col. 12, line 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Norton to the teachings of Suzuki in order to provide an alternative method of conducting transactions using the optical smart card in addition to use of the contactless smart card. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the card transaction terminal of Suzuki equipped with the optical/smart card reader of Norton to be portable, since it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art. *In re Lindberg*, 93 USPQ 23 (CCPA 1952).

6. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Simonds (US 2002/0023027, of record).

The teachings of Suzuki have been discussed above.

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Although, Suzuki teaches a device is a PDA and signal to be authenticated is a high-contrast optical signal.

Simonds teaches that the mobile terminal (33) such as PDA retrieve the barcodes image from the server for displaying on the display of the mobile terminal as proof of the purchase wherein the retrieved barcode image serves as a high-contrast optical signal to be authenticated/verified (see figs. 1-3; paragraphs 0021-0042).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Simonds to the teachings of Suzuki in order to verify the purchasing of goods/services by reading the barcode images displayed on the display device for enabling transaction therewith. Moreover, such modification (i.e., a memory for storing a session constituting transaction request and authentication signal) would have been a well known in the art at the time the invention was made to complete the particular transaction using the transaction request and result of the transaction request (e.g., the retrieved barcode images).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Barnes et al. (US 5,465,386, of record)(hereinafter referred to as 'Barnes').

The teachings of Suzuki have been discussed above.

Although, Suzuki teaches the cellular phone can communicate using DTMF signal via the DTMF interface, they fails to teach or fairly suggest that the DTMF signal is an audio frequency keying signal.

However, Barnes teaches a mobile communication system for communicating using AFSK signal (see Figs. 8-11; Abstract; col. 23, lines 7-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Barnes to the teachings of Suzuki in order to provide an alternative method for transmitting data/information using the well-known method such as ASKF instead of a frequency-keying signal.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Zele et al. (US 5,734,975, of record)(hereinafter referred to as 'Zele').

The teachings Suzuki have been discussed above.

Although, Suzuki teaches the cellular phone can communicate using DTMF signal via the DTMF interface, he fails to teach or fairly suggest that the DTMF signal is a PL signal.

However, Zele teaches that a portable radio receiver comprises a privacy feature known as private line (PL) (see col. 1, lines 11-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Zele to the teachings of Suzuki in order to provide an improved and an enhanced system for only activating the portable card reader for initiating transaction when the reader received particular signal.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Chesarek (US 4,386,266, of record)

The teachings of Suzuki have been discussed above.

Although, Suzuki teaches the cellular phone for reading information from keyboard, he fails to teach or fairly suggest that the terminating of the operation if a PIN entry is attempted more than predetermined number of times.

However, Chesarek teaches to terminate the transaction after predetermined number of tries to enter the PIN number (114) (see Fig. 9; col. 9, lines 47-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Chesarek to the teachings of Suzuki in order to provide an additional security means for allowing user(s) to enter PIN number predetermined number of times to prevent unlimited number of tries to enter PIN number. Moreover, such modification would provide an improved customer service since the terminal can be released to the other customers for accessing the data/information using the terminal.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Zhou et al. (US 5,796,858, of record)(hereinafter referred to as 'Zhou').

The teachings of Suzuki have been discussed above.

Although, Suzuki teaches a portable terminal having the card reader, he fail to teach that the card reader comprises a biometric input device.

However, Zhou teaches a cellular phone comprises a fingerprint sensing system (see Figs. 1-9; col. 7, line 53+).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Zhou to the teachings of Suzuki in order to provide an additional security for authenticating the user(s) with fingerprint during transactions such as downloading application and/or making payment for products.

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Ouimet et al. (US 6,823,317)(hereinafter referred to as 'Ouimet').

The teachings of Suzuki have been discussed above.

Although, Suzuki teaches a portable terminal having the card reader, he fails to teach that the card reader comprises a headset.

However, Ouimet teaches a portable terminal (18) comprises an audio headset (59) with card readers (53 and 55) for reading user confidential data (see fig. 5; col. 4, line 56- col. 5, line 64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ouimet to the teachings of Suzuki in order to provide an improved sales environment by requesting various information

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remotely using the headset and conducting financial transaction wirelessly/remotely using the card readers attached/affixed to the portable terminal therewith.

Response to Arguments

12. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner respectfully provides Suzuki reference wherein Suzuki reference teaches the cellular phone to initiate the electronic transaction as discussed above.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday-Friday, 7:30 AM- 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SEUNG HO LEE
PRIMARY EXAMINER